

STATUS OF THE CLAIMS

Claims 1-63 were subject to a restriction requirement. No new matter is added. Claims 1-63 are pending. Consideration of the present Application is respectfully requested in light of Applicant's Remarks made herein.

REMARKS

35 U.S.C. § 121 Rejections

The Examiner requested restriction of claims 1-63 pursuant to 35 U.S.C. § 121 as disclosing one or more distinct inventions in a single application. The Examiner imposed a requirement to restrict to one of the following three groups of claims for further examination in the above application:

- I. Claims 1-6, and 7-12, drawn to a method and system for providing computerized customized list of user-selectable diagnoses (class 705, subclass 3);
- II. Claims 13-39, drawn to a method and system for providing computerized customized list of user-selectable diagnoses utilizing database functionality, (class 707, subclass 100); and
- III. Claims 40-63, drawn to a system and method for facilitating medical diagnosis coding, (class 717, subclass 144).

For purposes of response and further prosecution, Applicant provisionally elects the claims of Group II, claims 13-39. This election is, however, made with traverse, and reconsideration and withdrawal of the restriction requirement is requested for the following reasons.

First, Examiner avers that the inventions are distinct because

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as storing and retrieving lists and records from a standard database. See MPEP § 806.05(d).

(Office Action, at 2). Applicant respectfully disagrees. A subcombination may be found to be distinct only if (1) the combination does not require the particulars of the subcombination as claimed for patentability, and (2) the subcombination can be shown to have utility either by itself or in another materially different combination. MPEP § 806.05(d). The separate use of subcombination II suggested by the examiner is not reasonable, “storing and retrieving lists and records from a standard database.” Subcombination I and II perform functions upon the same diagnoses/disease standard database and cannot be argued to be performing distinct uses.

Independent claims 1 and 7, of subcombination I, are directed towards “[a] method of providing a computerized list of user selectable diagnoses for facilitating medical coding by medical professionals.” (emphasis added). “Diagnoses” are determinations of which disease underlies a patient’s condition, and accordingly diseases and diagnoses are effectively interchangeable within the concept of Applicant’s invention. Independent claims 1 and 7 further require “searching data indicative of the ICD9-CM code for at least one item of the ICD9-CM code in accordance with at least one received request to add at least one diagnosis to the customized list.”

Likewise, independent claims 13, 20, and 35, of subcombination II, are directed towards “generating a customized list of diseases from a standard disease database.” (emphasis added). These uses are not distinct because independent claims 13, 20, and 35 require “searching the standard disease database.” The disease database that searches are to be performed upon is the same as that of independent claims 1 and 7, the International Classification of Diseases (“ICD”), published annually by the U.S. Federal government. The ICD provides “numeric codes for describing the ‘clinical picture’ of any patient.” (Application, at ¶ 3). Further, the ICD maintains three volumes, including a Tabular List of Diseases, an Alphabetic Index to Diseases, and a Tabular List and Alphabetic Index to Procedures. (Application, at ¶ 4-6). Both subcombinations I and II perform functions upon the ICD for determining particular diseases/diagnoses.

Accordingly, the Examiner is incorrect in stating that “subcombination II has separate utility such as storing and retrieving lists and records from a standard database.” Both

subcombination I and II are both directed towards “storing and retrieving lists and records from a standard database” – specifically the ICD; therefore, neither “subcombination can be shown to have utility either by itself or in a materially different combination.” MPEP § 806.05(d).

Second, Examiner argues (1) Inventions I and III are unrelated, and (2) Inventions II and III are unrelated. (Office Action, at 3). Applicant respectfully disagrees. “Two or more inventions are related (i.e. not independent) if they are disclosed as connected in at least one of design (e.g. structure or method of manufacture), operation, and effect.” MPEP § 802.01 (emphasis added). As discussed previously, it has been shown that Inventions I and II perform operations upon the ICD database. Invention III, in similar fashion, performs operations related to the ICD database, and, thus, is related to Inventions I and II.

For example, independent claim 40 provides “storing data corresponding to the tabular list of the ICD9-CM medical diagnoses coding;” independent claim 51 provides “data corresponding to the tabular list of ICD9-CM being stored in at least a first table so as to preserve a hierarchy associated with the ICD9-CM;” and independent claim 63 requires “generating a hierarchical organization associated with ICD-10.”

Clearly, inventions I, II, and III are related in that the claims require direct, or derivative, operations related to be performed on the ICD database. Furthermore, the language used by Examiner to state that inventions I and III, and inventions II and III are unrelated, is taken directly from ¶ 8.20.02, Unrelated Inventions. (Office Action, at 3 ¶ 4, 5). MPEP § 806.06 provides some guidance in the use of this paragraph, “[t]his form paragraph is to be used only when claims are presented to unrelated inventions, e. g., a necktie and a locomotive bearing not disclosed as capable of use together.” (emphasis added). It cannot be reasonably stated that invention I, II, and III are so unrelated as to be comparable to a “necktie and a locomotive bearing.” MPEP § 806.06. As has been shown, all three groups of claims perform operations, either directly or derivatively related, to the ICD database and are, therefore, capable of use together. The groups of claims specified by the Examiner are not unrelated.

It is further submitted that, in view of the fees charged for filing divisional patent applications and for prosecuting and maintaining the resulting patents, any restriction or election requirement must be clearly supported and made according to the patent examining procedure to

avoid an undue burden to the Applicant.

Based upon the above remarks, Applicant respectfully requests reconsideration of this restriction requirement and early allowance of the pending claims. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite prosecution of this application; the Examiner is urged to contact the undersigned attorney.

An early action on the merits of these claims is respectfully requested.

Respectfully submitted,

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A handwritten signature in dark ink, appearing to read 'C.H. Pierce', is written over a horizontal line.

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